

REMARKS

The Office Action mailed on September 23, 2005 has been carefully reviewed and considered. Claims 1-14 are previously pending and Claims 1-14 stand rejected. In the foregoing Amendments, Claims 1, 3-8 and 11 have been amended. Support for these amendments can be found in the specification and the claims of the application as filed. No new matter has been added. Claims 1-14 are currently pending in the application. Applicant respectfully requests entry of the foregoing Amendments and reconsideration of the present application in light of the amendments above and the remarks below.

In the specification, paragraph 1 has been amended to insert a patent number for a parent case. No new matter has been added.

The 35 U.S.C. § 102 Rejection

Claims 1-4 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Ellis et al.¹ ("Ellis"). Without admitting that Ellis is prior art and reserving the right to establish that it is not prior art, Applicant respectfully traverses this rejection for the reasons below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 869 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See also*, M.P.E.P. §2131.

Applicant respectfully submits that Ellis does not anticipate the presently claimed invention because Ellis fails to disclose each and every element set forth in the claimed invention. However, in order to expedite the allowance of the present application, Applicant has

¹ U.S. Publication No. 2003/0149988.

elected to amend independent claims to more specifically claim the present invention. For example, the amended Claim 1 of the present invention recites in part:

1. A gateway comprising:

a crossbar switching circuit having a plurality of input and output (“I/O”) ports;
(emphasis added)

In one embodiment, a crossbar switching circuit 112 controlled by CPU 118 routes the compressed data received by Receiver 106 directly to the hard disk 114 if a program is to be recorded. If, however, the program is to be viewed, the switching circuit 112 routes the compressed data to the decompression and conversion circuit 110, which processes the data for displaying. See FIG 3 and its corresponding description on page 16, lines 4 to 18 of the present application. An advantage of having a crossbar switching circuit or router 112 is that it is capable of routing compressed data directly to a storage device, and then retrieving the stored data later when the user is ready for viewing.

In contrast, Ellis discloses a program guide system that records programs at a remote media server in response to user requests. See paragraph 0012 on page 1 of Ellies. FIG 7 of Ellies, illustrated on next page, shows an arrangement for the user television equipment, which includes a digital storage device 31 and a communication device 37 wherein digital storage device 31 records programs and program guide data while communications device 37 communicates with program guide server 25, remote media server 24, or internet service. See paragraph 0098 to 0105 on page 8 of Ellis.

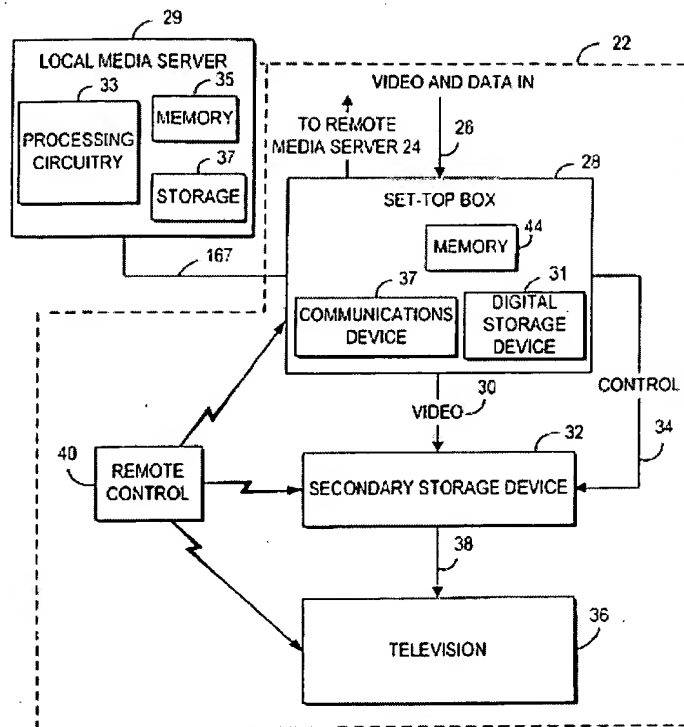


FIG. 7

Contrary to the presently claimed invention, Ellis does not disclose or mention a crossbar switching circuit or any equivalents thereof. At least for this reason, Claim 1 should be patentable over Ellis under §102. Since Claims 3-4 contain similar limitations as Claim 1, Claims 3-4 should also be patentable over Ellis under §102. If independent claims are valid, the claims that depend from the independent claims should also be valid as matter of law. See Jenric/Pentron, Inc. v. Dillon Co., 205 F. 3d 1377, 1382 (Fed. Cir. 2000). Since Claim 2 depend from allowable independent Claim 1, Claim 2 should also be patentable over Ellis under § 102.

The First 35 U.S.C. § 103 Rejection

Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ellis in view of Billerbeck et al.,² ("Billerbeck") among which claim 5 is independent claim.

² U.S. Patent No. 6,844,895.

Moreover, Claims 7-9, 12 and 14 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ellis in view of Isono et al.³ (“Isono”) among which claim 7 is independent claim. Furthermore, Claims 10-11 and 13 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ellis in view of Isono and further in view of Tidwell et al.,⁴ (“Tidwell”). These rejections are respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.⁵

As Claim 1, amended Claims 5-14 also contain a limitation of a crossbar switching circuit having a plurality of I/O ports. As discussed early, Ellis does not disclose a crossbar switching circuit as claimed in the present invention. Since Ellis together with Billerbeck do not disclose all of the claim limitations or equivalents listed in Claim 5 of the present invention, Claim 5 should be patentable over Ellis in view of Billerbeck under §103. Similarly, Claim 7, which contains similar limitations as Claim 5, should also be patentable over Ellis in view of Isono under §103. Since Claims 6 and 8-14 depend from allowable independent Claim 5 and 7, respectively, Claims 6 and 8-14 should also be patentable. In view of the foregoing, it is respectfully asserted that Claims 1-14 are now in condition for allowance.

³ U.S. Patent No. 6,216,171.

⁴ U.S. Publication No. 2001/0043687.

⁵ M.P.E.P § 2143.

The Applicant further submits that he disagrees with several assertions made in the Office Action. The Office Action asserts the following statements:

- “Tuner/communication circuitry ‘Tuner/CC’ of STB -28 or Satellite Receiver,” see page 2 of the Office Action;
- “note that STB-28 CD-37/51 is a network interface device to LAN devices, such as: Local Media Server 29 or Secondary Storage device 47, digital storage device 49, DVD, digital VCR, PC, etc.” see page 3 of the Office Action;
- “note that STB-28 receives low and high frequency signals, from satellite, internet link, serial or parallel link, network link, and other wired or wireless digital or analog link and alters the bandwidth of data routed through the devices on the LAN and STB-28 CC/ProC-42 exchanges data at high data rate between STB-28 and MF-12 or DF-16 to meet user interactive requests, on-demand,” see pages 3-4 of the Office Action;
- “note that ProC-33 of LMS-29 is also contained in STB-28 and UserTVE/LMS-22/29 or STB-28 receives digital compressed MPEG-2 data stream transmitted from Main facility (MF) 12 or Distribution Facility (DF) 16 or RMS-24 (page 6, [0088-0090]) and UserTVE/LocalMS-22/29 or STB-28, demultiplexes, decodes, encodes, conditional access, decryption, decompresses and converts (CC/ProC within STB-28 or Local-MS-29) the received data to analog NTSC for display of NTSC-TV 36/54 (page 14, [0157]), furthermore UserTVE/LocalMS-22/29 or STB-28 also receives IP data (which includes guide data, program data, etc.,) via communication path 20 (page 9, [0115]),” see page 4 of the Office Action;
- “note that Tuner/CC upon user’s request records/playback programs to/from LocalMS-29 or R/P devices,” see page 5 of the office action; and
- “note that the storage device 31 can be contained in STB-28 or external from the STB 28 and contained in LocalMS-29 (page 8, [0102] and [0104]), furthermore Processing circuitry (ProC or CC-42) can be contained in STB-28, LocalMS-29, R/P Devices or TV-36 and STB-28 receives and processes and converts the IP data, MPEG data to appropriate format for display on the analog NTSC TV display-36/54,” see page 6 of the Office Action.

After reviewing the prior art in light of the assertions, Applicant could not verify that these assertions were taught or disclosed in the prior art as indicated in the Office Action. For example, the Applicant could not verify the assertion that Figs. 7, 9 and paragraphs [0102] and [0112] of Ellis discloses or teaches a “Tuner/communication circuitry ‘Tuner/CC’ of STB -28” as

stated in the Office Action. Therefore, Applicant assumes that the Office Action intended to take official notice of facts under M.P.E.P. 2144.03 as common knowledge in the art or "well-known" prior art. Under M.P.E.P. 2144.03, if the applicant adequately traverses such an assertion the examiner should cite a reference in support of his or her position. Applicant hereby traverses the assertion and requests that a reference be cited in support of the position outlined in the Office Action if the rejection is to be maintained.

Conclusion

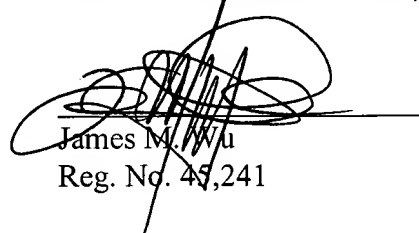
Based on all of the above, Applicant believes all claims now pending in the present application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

A petition for extension of time for one (1) months is enclosed. No additional fees are believed to be due at this time. However, please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Applicant thanks the Examiner for carefully examining the present application and if a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Jim Wu at (408)282-1885.

Respectfully submitted,

THELEN REID & PRIEST, LLP



James M. Wu
Reg. No. 45,241

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Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040